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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/641,709	08/21/2000	Tsutomu Niwa	36595:165795	8841

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VENABLE, BAETJER, HOWARD AND CIVILETTI, LLP
P.O. BOX 34385
WASHINGTON, DC 20043-9998

EXAMINER

BRÖCKETT, JULIE K

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 09/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/641,709

Applicant(s)

NIWA, TSUTOMU

Examiner

Julie K Brockett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 18, 2003 has been entered.

Claim Objections

Claim 7 is objected to because of the following informalities: the claim states "big inner winning state". This is a typo. Either the word "inner" needs to be deleted or a "w" must be inserted at the beginning of the word so it reads "winner". Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "said current notifying state" in the last line. The amendment changed all prior "current notifying states" to "current game states". Consequently, there is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, and 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sunaga et al., U.S. Patent No. 6,106,393 in view of Kaufman, U.S. Patent No. 4,624,459. Sunaga et al. discloses a game machine which is a slot machine with shift and display means for shifting and displaying a plurality of rows each having a plurality of symbol marks thereon (Fig. 2). A prize state determining means, determines a prize-winning state based on a random number lottery. The prize-winning state can be a big or medium winning state (col. 10 lines 11-15). Furthermore, stop control means control the stop and shift display means so as to have a set of symbol marks shifted and displayed on the basis of the prize state determined by the prize winning state determining means (col. 6 lines 30-34 & Fig. 4). A notifying

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means is used for notifying a game player of information in the game states including a current game state while the player is enjoying the games. The information in the current game state is information about the game currently being played before the shift and display means is stopped at the end of the current game to have a set of symbols displayed. Furthermore, the notifying means is operative to notify the game player of the game state corresponding to the prize winning state at a predetermined probability and the information notified by the notifying means corresponds to specified prize winning state determined by the prize winning state determining means (col. 4 lines 1-12, 21-40; col. 10 lines 3-19). For example, if the current game is going to result in a "Big Jackpot" as a result of the random number selection, a demonstration using lights, sounds, staggering the reel start times, etc. notifies the player of this information, prior to the reels stopping on the machine. The game machine includes a medal-inserting slot for starting the game (col. 4 lines 46-48). Sunaga et al. lacks in disclosing notifying the player of subsequent game states.

Kaufman teaches of a gaming device in which a notifying means informs the player of subsequent game states following the current game state, while the player is enjoying the current game. The game includes a subsequent game state determining means for determining and selecting in advance the subsequent notifying states in the current game based on the current notifying state that is informed to the player by the notifying means (col. 3 lines 45-65).

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For example, the player is notified of the current game state through the display of the combination of symbols after the reels have stopped. Based on whether or not this is a winning combination, the player is then informed of a multiple payout by the multiple payout indicator, i.e. subsequent notifying state. Furthermore, it would have been obvious to have the notifying means operative to notify the game player of the game state determined by the subsequent game state determining means when a the current or subsequent game starts with a game medium inserted into the token accepting slot. Most games are started with the deposit of coins into a slot; consequently, it is obvious to start notifying players of their winnings once the game has been started. Moreover, it would have been obvious at the time the invention was made to include Kaufman's method of notifying player's of subsequent game states in the invention of Sunaga et al. By informing players of subsequent game states, a player who might have otherwise lost interest in playing a game may be encouraged to continue playing in order to reap the benefits of the subsequent game state if it is known prior to playing the game. Consequently, more players would play the gaming devices for longer periods of time making it profitable to the game owner.

Allowable Subject Matter

Claims 2, 4 and 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten to overcome the rejection(s)

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under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The prior art of record does not teach or suggest a second game state determining means for determining and selecting in advance the current game states on the basis of the subsequent game states. The prior art only discloses determining both the current game states and the subsequent game states separately based on random number selection. Furthermore, the prior art does not teach of continuing to notify the game player of the identical game state without interruption when the current game state is identical to the subsequent game states. The prior art combination of Sunaga et al. and Kaufman, discloses different types of game states, therefore, they can not be identical. The prior art also lacks in storing variation values each showing a relationship between the current game state and the subsequent game state. No such storage means exists in the prior art of record.

Response to Amendment

It has been noted that claims 1-6 and 9 have been amended.

Response to Arguments

Applicant's arguments with respect to claims 1-9 have been considered but are moot in view of the new ground(s) of rejection.

Citation of Relevant Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1. Shuster, U.S. Patent No. 6,270,409 B1.

--Shuster discloses a gaming method and apparatus where players are notified when certain win intervals have been achieved and are told that the next game will result in a win.

2. Acres, U.S. Patent No. 6,375,567 B1.

--Acres discloses notifying the player of the current state of the game through a "spin the wheel" message appearing on the display.

3. Okada, U.S. Patent No. 5,018,737.

--Okada discloses notifying a player of a hit even when the game is still in progress.

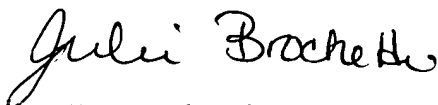
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie K Brockett whose telephone number is 703-308-7306. The examiner can normally be reached on M-Th 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg SPE can be reached on 703-308-1327. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the customer service office whose telephone number is 703-306-5648.

A handwritten signature in cursive script that reads "Julie Brockett".

Julie Brockett

Examiner

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September 3, 2003